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SERIAL NUMBER 087930.645	FILING DATE 12/01/97	FIRST NAMED APPLICANT SMITH	ATTORNEY DOCKET NO. C TRAK02222
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EXAMINER ZANELLI, M	
ART UNIT 3661	PAPER NUMBER b

DATE MAILED: 11/25/98

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

see attached

Office Action Summary

Application No.

08/980,645

Applicant(s)

Smith et al.

Examiner

M. Zarelli

Group Art Unit

3661

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 6/21/98
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 32, 33 & 37-93 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☒ Claim(s) 32, 33, 38, 39, 41 & 43-45 is/are allowed.
- ☒ Claim(s) 37, 40, 42, 44-93 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3 & 5
- ☐ Notice of References Cited, PTO-892
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

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DETAILED ACTION

1. This application is acknowledged as a division of application 08/549380, filed 10/27/95, and issued as patent 5,835,376. The preliminary amendment filed 6/29/98 has been entered. Claims 32, 33, and 37-93 are currently pending.
2. The prior art filed 4/27/98 and 7/27/98 has been considered. Note that patent 4,092,718 has been cited twice.
3. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.
4. Claims 37, 40, 42, 46, 62-90, and 93 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
 - A. As per claims 37, 40, 42, 46, and 62, the claims are indefinite due to the use of the alternative "or". The examiner suggests rewriting the claims as "any one of ... and ...".
 - B. As per claims 63 and 93, the claims lack nexus between what is recited in the preambles and the body of the claims. The claim preambles recite "controlling a vehicle"; however, the claim bodies do not provide this function.
 - C. All claims depending from a rejected base claim are also rejected as containing the same deficiencies.

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5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 47-93 are rejected under the judicially created doctrine of double patenting over claims 1-38 of U. S. Patent No. 5,835,376 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: For example, application claim 47 is a subcombination of the subject matter recited in patent claim 1. The scope of patent claim 1 incorporates the broader subject matter recited in application claim 47.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

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7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 47, 49, 51, 52, 54-57, 59, 61, and 91 are rejected under 35 U.S.C. 102(b) as being anticipated by Wendt (4,092,718).

A. As per claims 47 and 91, Wendt discloses a system for dispatching vehicles without human intervention based on requests for transportation service. The central computer receives request information from service requesters as well as information regarding the status of a plurality of transportation vehicles (i.e., passenger and location data) (col. 1, lines 49-56). An automated dispatcher plots routes for the transportation vehicles to service the requests (col. 2, lines 9-13).

B. As per claims 49, 51, 52, 54, and 59, as above wherein Wendt further discloses using two-way radio communication devices as well as land lines to transfer information between the central station, vehicles, and service requesters (col. 3, lines 14-20, 58-62; col. 4, lines 14-22).

C. As per claims 55-57, as above wherein Wendt further discloses providing a plurality of remote request stations which allow a user to manually input transportation requests via land lines to the central station (col. 3, lines 25-47).

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D. As per claim 61, as above wherein Wendt discloses a dispatching process which transmits route information to the vehicle based on the transportation requests (col. 1, lines 49-56).

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

11. Claim 53 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wendt (4,092,718) in view of Gooch (5,396,540).

A. Wendt is applied as above. Wendt discloses using a combination of land line and radio wave communications. Claim 53 differs in that satellite-based radio communication is utilized. However, at the time of applicant's invention it was known in the art to communicate and monitor the status of vehicles from a central location

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using a combination of satellite-based and ground-based communication systems. For example, Gooch discloses a communication system for monitoring and communicating with vehicles from a remote location. As shown in Fig. 1, the system uses a combination of satellite-based and ground-based communication devices. One of ordinary skill in the art would have found it obvious to substitute the communication system of Gooch for that disclosed by Wendt because the satellite-based communications would have allowed one to provide communication over a wider area as well in environments which would limit ground-based radio communications.


12. As per claims 32, 33, 38, 39, 41, and 43-45, the prior art of record does not disclose or reasonably suggest identifying a route to be followed based on routing criteria which ensures reimbursement for transportation costs by a third party payor.

13. Claims 37, 40, and 42 would be allowable if rewritten or amended to overcome the rejections under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Michael Zanelli** whose telephone number is (703) 305-9756 (M-Th, 6:30-5:00 PM).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

/mjz
November 19, 1998


MICHAEL ZANELLI
PRIMARY EXAMINER